

ARGUMENTS IN SUPPORT OF ALLOWABILITY

In re "102" Rejection of Claims 1-2

Examiner rejected claims 1-2 under 35 USC 102(e) as being anticipated by Miller.

Applicant traverses these rejections for the reason that the invention defined by claims 1-2 defines "an integral lamp unit" (emphasis added), which -- especially when interpreted in light of the specification (Fig. 1) -- is clearly a different entity than Miller's "Lampholder Fitting". (The word "integral" means: "formed as a unit".)

Never-the-less, to make it abundantly clear that Applicant's "integral lamp unit" is indeed integral, claims 1-2 have been amended by adding the provision that the different parts are non-detachably held together.

In re "103" Rejection of Claims 3-4, 6-11 and 13-14

Examiner rejected claims 3-4, 6-11 and 13-14 under 35 USC 103 as being unpatentable over Miller in view of Zuchtriegel.

Applicant traverses these rejections for the following reasons.

(a) Although Zuchtriegel's patent indicates a date of Oct. 16, 1979, Examiner has provided no evidence to the effect that this date constitutes the date on which Zuchtriegel's invention was first "described in a printed publication".

Applicant believes that the date of Oct. 16, 1979 represents Zuchtriegel's filing date, not the date on which his invention was published. Commonly, the publication date is substantially later than the filing date.

(b) The explanation provided above in connection with Applicant's traversal of Examiner's rejection of claims 1-2 pertains to claims 3-4, 6-11 and 13-14 as well.

(c) Examiner states that it would have been obvious to apply the teachings of Zuchtriegel to those of Miller for the reason that Miller's arrangement calls for a frequency converter without specifying any specific design. Therefore, since Zuchtriegel describes a frequency converter, a skilled artisan might reasonably have chosen Zuchtriegel's design.

However, Miller actually teaches away from using a frequency converter such as Zuchtriegel's.

Miller expressly calls for a "low voltage" frequency converter (see element 18 of Fig. 2 as well as lines 55-56 of column 2 and lines 9-10 of column 3 -- also, in line 49 of column 3, note that Miller's element 9 is a step-down transformer). To a person having ordinary skill in the art of frequency converters, the term "low voltage" frequency converter would refer to a frequency converter adapted to be powered from (typically) a 12 Volt DC power supply. Zuchtriegel, on the other hand, describes a frequency converter that is adapted to operate directly on rectified power line voltage; which means that Zuchtriegel's is a "high voltage" frequency converter in the terminology of a person familiar with the art of frequency converters.

Thus, a skilled artisan would not have looked to Zuchtriegel for a design suitable to make the "low voltage" frequency converter called-for by Miller.

(d) Examiner has provided no rational line of reasoning that would lead from Miller to Zuchtriegel. Rather, it appears that Examiner has chosen Zuchtriegel for the principal reason of attempting to find something that -- if combined with Miller -- might result in my claimed invention.

In re "103" Rejections of Claims 13 and 15

Examiner rejected claims 13 and 15 under 35 USC 103 as being unpatentable over Miller in view of Zuchtriegel and Crane.

Applicant traverses these rejections for substantially the same reasons as he provided above in connection with his traversal of Examiner's rejection of claims 3-4, 6-11 and 13-14.

In re All 102/103 Rejections

Applicant traverses all of Examiner's 102/103 rejections for the reason that Examiner failed to provide evidence of non-patentability of the claimed invention.

Applicant bases his traversal on the following facts and analysis.

(a) According to Law, Applicant is entitled to a patent for his invention unless Examiner provides evidence of non-patentability. (See 35 U.S.C. 102/103 and In re Nomiya)

(b) As evidence of non-patentability, Examiner presented certain prior art documents and an interpretation of the subject matter therein as it pertained to the claimed invention.

(c) Both the claimed invention and the prior art documents pertain to highly specialized subject matter, subject matter which a person without correspondingly special background/skill/expertise would be unable to properly comprehend and integrate.

(d) A prior art document pertaining to a highly specialized subject matter does not by itself constitute legally relevant evidence. For it possibly to constitute legally relevant evidence, such a prior art document must be combined with an appropriate interpretation; and this interpretation must be rendered by an individual possessing the particular competence required to render such interpretation. Moreover, evidence must to be provided to the effect of verifying the adequacy of the competence of the individual rendering the interpretation.

(e) Examiner has provided no evidence with respect to the qualifications of the individual who rendered the interpretation of the prior art documents upon which Examiner based his opinion of non-patentability. Consequently, Examiner has in fact not provided any evidence of non-patentability.

(f) Applicant has been told by the PTO to the effect that the role of the examiner is to perform "an administrative and adjudicative" function, and that the particular professional qualifications of the examiner are immaterial. The examiner can therefore not be expected to possess the above-indicated special background/skill/expertise. That is, he can not be expected to possess adequate competence to render a proper interpretation of the above-indicated highly specialized subject matter.

(g) An opinion (prima facie or not) with respect to a highly specialized subject matter rendered by an individual lacking the special background/skill/expertise associated with that subject matter, must be considered as an uninformed opinion.

(h) According to conventional rules of evidence, for an opinion (prima facie or not) to have legal relevance, it must constitute an informed opinion.

Hence, in accordance with basic rules of evidence, since Examiner failed to provide evidence with respect to the qualifications of the individual who provided the interpretation (of the contents of the prior art documents and their relationship with the claimed invention) upon which Examiner based his rejections, Examiner's rejections are invalid for lack of legally relevant evidence of non-patentability.

In regard to what constitutes qualifications adequate to properly interpret and apply facts associated with the particular art pertinent to the claimed invention, Applicant submits that such qualifications are implicitly and appropriately defined by paragraph 103 of the Patent Laws.

In paragraph 103, with respect to the subject matter sought to be patented, express reference is made to "a person having ordinary skill in the art to which said subject matter pertains".

To Applicant, it is clear that the qualifications required to properly interpret the particular subject matter related to the claimed invention and the applied prior art references are exactly those of "a person having ordinary skill in the art to which said subject matter pertains".

In re Motivation

To reject a claim under 35 U.S.C. 103, it is necessary for Examiner to provide plain and clear evidence of motivation operative to cause a person having ordinary skill in the pertinent art ("skilled artisan") to seek to modify (and/or combine) the applied reference(s) in such exact manner as to attain the invention as it is specifically defined.

Clearly, to be motivational in the sense of leading an artisan to seek to attain a structure or combination such as that specifically defined by the claimed invention (which specific structure or combination is, of course, what the claimed invention is), evidence of motivation must be specific enough (and plain and clear enough) to cause the artisan to seek to attain that particular structure or combination as it is specifically defined.

Moreover, in order for motivation to exist there must be plain and clear evidence of desirability; which desirability must pertain to the particular structure or combination actually claimed: it can not be some general desirability pertaining to other structures or combinations as well.

Thus, Examiner must provide plain and clear evidence of desirability with respect to the structure or combination particularly defined by the claimed invention.

So, before the question of obviousness of the claimed invention can even be addressed, Examiner must identify some desirability (over the prior art) attributable to the claimed structure/combination as it is specifically defined.

Thereafter, if he were to be successful in identifying such desirability, Examiner must explain how the applied reference(s) -- when viewed by the skilled artisan as part of the literally tens of thousands of other references in the pertinent art -- constitute plain and clear evidence of such desirability.

Only after having provided evidence of obvious desirability would it be appropriate to consider whether this obvious desirability might be attained by obvious modifications and/or combinations of the applied reference(s).

In re "Line of Reasoning"

As a result of recent interactions with the Board or Appeals, Applicant has come to recognize a certain concept that both the Board and Applicant can agree upon as being reasonable. That certain concept might best be expressed as the requirement -- in case of a "103" obviousness rejection -- for Examiner to set forth a clear "line of reasoning" in support of his rejection; which "line of reasoning" must have its beginning in some primary reference and, on the basis of information provided by that primary reference, clearly lead to any secondary reference(s) and eventually to the claimed invention as it is expressly defined by the rejected claim.

As a basic component of this "line of reasoning" concept, Applicant quotes from In re Nilssen (CAFC 88-1139):

"The person of ordinary skill is presumed to have access to the entire art not because he unrealistically carries the entire art in his head but because he knows how to find information in the art by researching accessible sources".

Thus, a skilled artisan does not carry the entire pertinent art in his head. Rather, from the primary reference, the artisan must be motivated to search for the type of teachings represented by any secondary references. Clearly, the motivation to search for teachings such as those of a given secondary reference can not come from this secondary reference.